

James A. Bonini, et al.
Serial No.:09/609,146
Filed: June 30, 2000
Page 2

In the Title of the Invention:

Please delete the title and replace with the following title:

--PROCESSES FOR OBTAINING COMPOUNDS EMPLOYING SNORF72 RECEPTORS--

REMARKS

Claims 235-251, 254-263, 266-271, and 276-281 were pending in the subject application. Accordingly, upon entry of this Amendment, claims 235-251, 254-263, 266-271, and 276-281 will be pending and under examination.

Applicants maintain that the amendments to the Title of the Invention raise no issue of new matter and is fully supported by the specification as filed.

Accordingly, applicants respectfully request that this Amendment be entered.

1. Objection to the Title of the Invention

On page 2 of the January 29, 2003 Office Action, the Examiner alleged that the title of the invention is not descriptive. The Examiner then requested a new title that is clearly indicative of the invention to which the claims are directed.

In response to the Examiner's objection to the title, applicants have amended the title to more accurately describe the claimed

James A. Bonini, et al.
Serial No.:09/609,146
Filed: June 30, 2000
Page 3

subject matter.

2. Rejection under 35 U.S.C. §112, second paragraph

On page 2 of the January 29, 2003 Office Action, the Examiner rejected claims 235-251, 254-263, 266-271 and 276-281 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The Examiner alleged that claims 235-251, 254-263, 266-271 and 276-281 are vague and indefinite because independent claims 235, 243, 249, 254 and 266 encompass a process involving competitive binding for identifying a chemical compound which specifically binds to a mammalian SNORF72 receptor or is an antagonist, by contacting cells with both a chemical compound and a second chemical compound known to bind to the receptor or known to be an agonist, and separately contacting cells with only the second chemical compound known to bind to the receptor, and comparing the amount of binding of the second chemical compound under the two conditions. The Examiner then alleged that the claims are indefinite because it is not clear what chemical compounds were known and were not known to bind to the receptor, and therefore the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

In response, applicants respectfully traverse the Examiner's rejection of claims 235-251, 254-263, 266-271 and 276-281 under 35 U.S.C. §112, second paragraph for the following reasons.

James A. Bonini, et al.
Serial No.:09/609,146
Filed: June 30, 2000
Page 4

M.P.E.P. Section 2173.02 states:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Applicants maintain that the language of independent claims 235, 243, 249, 254 and 266 sets out and circumscribes a particular subject matter with a reasonable degree of clarity and particularity and thus fulfills the requirements of 35 U.S.C. §112, second paragraph. Applicants further maintain that the skilled artisan would readily understand what chemical compounds are known to bind to the SNORF72 receptor or known to be an agonist of the SNORF72 receptor in light of the numerous examples, methods, and results taught in the specification of the pending application. Applicants specifically note page 53, line 32 through page 54, line 2; page 110, line 5 through page 114, line 31; Tables 1, 1A and 2; and Figures 7, 8, 11A, 11B, 12, and 22, which describe compounds (i.e. neuromedin U peptides) that bind to the SNORF72 receptor and are agonists of the SNORF72 receptor.

James A. Bonini, et al.
Serial No.:09/609,146
Filed: June 30, 2000
Page 5

Applicants respectfully request that this rejection be withdrawn in light of the remarks made hereinabove.

3. Rejection under 35 U.S.C. §102(e)

On page 3 of the January 29, 2003 Office Action the Examiner rejected claims 235, 238-244, 246-249, 260-276 and 279 as being anticipated by Elshourbagy et al., U.S. Patent No. 6,461,836, effective filing date November 5, 1999. The Examiner alleged that Elshourbagy et al. discloses a protein identified as human AxOR34 (SEQ ID NO: 2) that is 98.9% identical to the amino acid sequence of SEQ ID NO:4 and 79% identical to SEQ ID NO: 25 of the instant application. The Examiner also alleged that Elshourbagy et al. discloses that AxOR34 is a receptor that binds neuromedin U ligands, and that the receptor can be used to screen for compounds that bind to it using competitive binding assays, wherein binding, inhibition or activation can be measured by second messenger systems including detection of calcium or other ions and cells such as insect cells and COS cells that can be used to express the receptor. The Examiner also alleged that Elshourbagy et al. teaches that agonists and antagonists to the receptor are encompassed in the invention, and that polypeptides of the invention can be in a formulation comprising a carrier for administration.

In response, applicants note that the filing date of Elshourbagy et al., U.S. Application No. 09/545,94, now U.S. Patent No. 6,461,836, is April 10, 2000. Attached hereto as **Exhibit A** is a copy of U.S. Serial NO. 09/435,384, filed November 5, 1999, the

James A. Bonini, et al.
Serial No.:09/609,146
Filed: June 30, 2000
Page 6

priority document for U.S. Patent No. 6,461,836. Attached hereto as **Exhibit B** is a copy of U.S. Patent No. 6,461,836 wherein applicants have highlighted the subject matter that was presented for the first time in U.S. Application No. 09/545,944 filed April 10, 2000, i.e., the subject matter not entitled to a November 5, 1999 priority date. As evidenced therein, all disclosures of the receptor ligand (neuromedin U peptides) were added for the first time in the April 10, 2000 filing of U.S. Application No. 09/545,944, now U.S. Patent No. 6,461,836. Accordingly, applicants maintain that U.S. Patent No. 6,461,836 (Elshourbagy, et al.) is effective as a reference against subject matter requiring knowledge of a compound which binds to the receptor only as of April 10, 2000.

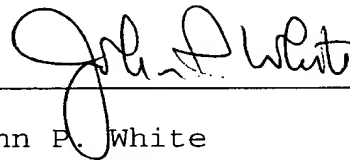
Applicants will in due course submit a Declaration Under 35 U.S.C. §1.131 establishing a date of invention prior to the effective date of Elshourbagy as a reference. Based upon the submission of such a declaration applicants will request that Elshourbagy be removed as a reference and that the rejections under 35 U.S.C. §102(e) and §103 be withdrawn.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

James A. Bonini, et al.
Serial No.:09/609,146
Filed: June 30, 2000
Page 7

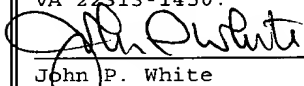
No fee, other than the enclosed fee of \$930.00 for a three-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Attorney for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


John P. White
Reg. No. 28,678

7/29/03
Date